

**REMARKS**

Claims 1-8, 10-23 and 26-36 were pending in the present application. Claims 26-34 were previously withdrawn from consideration. By virtue of this response, claims 5 and 12 have been cancelled, claims 1, 6, 8, 13, 14, 20, 23 and 35 have been amended, and new claims 37 and 38 have been added. Accordingly, claims 1-4, 6-8, 10, 11, 13-23, and 35-38 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added. Support for the amendments and for new claims 37 and 38 may be found throughout the specification, but particularly in paragraphs [0015]-[0017].

**Allowable Claims**

Claims 5-7, 12-14 and 21 were objected to in the Office Action of July 13, 2006, without indicating why these claims were objected to. It appears that claims 5-7, 12-14, and 21 are otherwise allowable, but that they depend from a rejected base claim. In response, the Applicant has amended claims 1 and 8 to incorporate the features recited in objected-to claims 5 and 8, respectively. Thus, the Applicant believes that claim 1 (and dependent claims 2-4, 6, 7) and claim 8 (and dependent claims 10, 11, and 13-19) are allowable as amended.

**Rejections Under 35 U.S.C. § 102***Claims 1-4*

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 746,869 to Moulton ("Moulton I").

The Applicant respectfully disagrees. As described above, claim 1 (from which claims 2-4 depend) has been amended to recite an obstructing member that is configured to allow air to flow *through a small area of the aperture in an exhalation direction and through a larger area of the aperture in an inhalation direction*. Moulton I does not show or describe this feature, nor do any other references cited by the Office Action.

In order to anticipate a claim, a reference must disclose each and every feature of the claimed invention. MPEP §2131. Since Moulton I does not show at least the feature described above, it cannot anticipate claims 1-4. Thus, the Applicant respectfully requests that the rejection of claims 1-4 as being anticipated by Moulton I be withdrawn and that these claims proceed to allowance.

*Claims 1-4, 8, 15, 20, 22, 35 and 36*

Claims 1-4, 8, 15, 20, 22, 35 and 36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 774,446 to Moulton (“Moulton II”).

The Applicant respectfully disagrees. As just described, claim 1 (from which claims 2-4 depend) has been amended to recite an obstructing member that is configured to allow air to flow *through a small area of the aperture in an exhalation direction and through a larger area of the aperture in an inhalation direction*. Moulton II also does not show or describe this feature. Thus, Moulton II cannot anticipate claims 1-4, and the 35 U.S.C. § 102(b) rejection of claims 1-4 should be withdrawn.

Claim 8 (from which claims 15 depends) has been amended to recite that the aperture of the device has a first area and a second area, that is larger than the first area, wherein the valve is configured to *permit fluid flow through only the first area in a direction from the inside surface to the outside surface, and through both the first area and the second area in a direction from the outside surface to the inside surface*. Moulton II does not show or describe this feature, nor do any other references cited by the Office Action. Thus, Moulton II cannot anticipate claims 8 and 15, and the 35 U.S.C. § 102(b) rejection of claims 8 and 15 should be withdrawn.

Claim 20 (from which claim 22 depends) recites a device having at least one valve configured to create a first flow resistance to inspiration and a second flow resistance to partially obstruct expiration, wherein the *first flow resistance is less than the second flow resistance*. Moulton II does not show or describe a device having a valve configured so that a first and a second

flow resistance are different. Instead, the device taught by Moulton II has a pair of valves (shown as elements 9 and 10 in figures 2, 3 and 5) that symmetrically divide the opening 8. The valves 9 and 10 shown and described in Moulton II are arranged so that one opens in one direction and the other opens in the opposite direction, however, the first airflow through the valve would be substantially the same as the second airflow through the valves, since the valves 9 and 10 are the same size and shape (as shown in Figure 2 of Moulton II), and made of the same material. Furthermore, there is no suggestion in Moulton II (or any of the other references described in the Office Action) to modify the Moulton II device to include a valve having a first (inspiratory) flow resistance that *is less than* a second (expiratory) flow resistance. Thus, Moulton II cannot anticipate claims 20 and 22, and the 35 U.S.C. § 102(b) rejection of claims 20 and 22 should be withdrawn.

Claim 35 (from which claim 36 depends) recites a valve device that is configured to *partially limit expiratory fluid flow directed from the inside surface to the outside surface more than inspiratory fluid flow from the outside to the inside surface*. As described above, the pair of valves shown in Moulton II (valves 9 and 10) are the same size and shape and do not limit airflow in one direction more than the other. In particular, the valves 9 and 10 would not limit expiratory flow more than inspiratory flow, as recited by claims 35 and 36. Thus, Moulton II cannot anticipate claims 35 and 36, and the 35 U.S.C. § 102(b) rejection of claims 35 and 36 should be withdrawn.

### **Rejections Under 35 U.S.C. § 103**

#### *Claims 10-11*

Claims 10-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moulton II in view of U.S. Patent No. 5,865,170 to Moles (“Moles”).

The Applicant respectfully disagrees. As described above, Claim 8, from which claims 10 and 11 depend, has been amended to recite the features of claim 12 (which was objected to but not rejected). Thus, Claim 8 now recites a valve that is configured to *permit fluid flow through only the first area in a direction from the inside surface to the outside surface, and through both the first area and the second area in a direction from the outside surface to the inside surface*. Moulton II

does not teach or suggest such a valve. Furthermore, Moles cannot cure this deficiency. Moles teaches only a customizable mouthpiece for scuba-divers.

The Office Action alleges that the combination of the valve of Moulton II with Moles mouthpiece makes claims 10 and 11 obvious because “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mouthpiece of Moulton to be substantially u-shaped as taught by Moles because Moles discloses that the u-shape of the body provides a resting place for the user’s lips.” The Applicant respectfully disagrees. In particular, there is no motivation to combine Moles and Moulton II (or Moulton I).

Moles and Moulton II are directed to non-analogous arts. Moulton II describes a device for preventing snoring. This device is to be used during sleeping. Moles describes a customizable mouthpiece for scuba-divers, to be used when scuba diving. These two arts (snoring therapies and scuba diving) are non-analogous. One of skill in the art would not look for a sleeping therapy in the scuba-diving arts (when sleeping would be particularly dangerous). Thus, the Moles reference is not in the field of applicant's endeavor (or even Moulton II's field of endeavor), and furthermore, Moles is not reasonably pertinent to the particular problem with which the inventor was concerned – i.e., treating a breathing disorder such as snoring. MPEP §2145.

Furthermore, the motivation offered by the Office Action for combining Moles and Moulton (providing a resting place for the user’s lips) is not a valid motivation. A user of the Moulton II device does not apparently need a resting place for his or/her lips. There is no suggestion in Moulton II that a user would need or benefit from having a mouthpiece such as Moles on which to rest the lips. This cited motivation is a benefit of Moles scuba-diving mouthpiece, however there is no suggestion (in Moles or elsewhere) that this feature could or should benefit a valve device as described in Moulton II.

In order establish *prima facie* obviousness of a claim, a reference (or combination of references) must teach or suggest all of the features of the claim, and there must be a motivation to combine the references. See MPEP §2143.03. Thus, claims 10-11 cannot be obvious over the

combination of Moulton II and Moles, since neither of these references (alone or in combination) teach or suggest all of the features recited in claims 10-11. The Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of claims 10 and 11, and allowance of these claims.

*Claims 16-19*

Claims 16-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moulton II.

The Applicant respectfully disagrees. Claims 16-19 ultimately depend from claim 8. Claim 8, as described above, has been amended to recite the features of claim 12, and now recites a valve that is configured to *permit fluid flow through only the first area in a direction from the inside surface to the outside surface, and through both the first area and the second area in a direction from the outside surface to the inside surface*. Moulton II does not teach or suggest such a valve. Thus, claims 16-19 cannot be obvious over Moulton II. The Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of claims 16-19 over Moulton II, and allowance of all of the pending claims.

*New claims 37 and 38*

New claims 37 and 38 are believed to be patentable over all of the cited references for at least the reasons provided above.

**CONCLUSION**

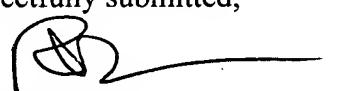
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **606492000201**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: December 13, 2006

Respectfully submitted,

By



Rick Shoop  
Registration No.: 45,763

MORRISON & FOERSTER LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
(650) 813-5804